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Paper No. 8

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JUN 18 2004

OFFICE OF PETITIONS

In re Application of :
Morse, Callas, Orth, Frazier, and :
Chin :
Application No. 10/001,416 : DECISION REFUSING STATUS
Filed: 15 November, 2001 : UNDER 37 CFR 1.47(a)
Attorney Docket No. 80121-06507 :

This is in response to the petition under 37 CFR 1.47(a) filed on
28 May, 2004.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of
this decision to reply, correcting the below-noted deficiencies.
Any reply should be entitled "Request for Reconsideration of
Petition Under 37 CFR 1.47(a)," and should only address the
deficiencies noted below, except that the reply may include an
oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.
Extensions of time may be obtained in accordance with 37 CFR
1.136(a).

The above-identified reissue application was filed on 15
November, 2001, without an executed declaration. Accordingly, on
28 November, 2003, a non-final Office action was mailed
requiring, *inter alia*, an executed reissue declaration, and
setting forth a three (3) month shortened statutory period for
reply. In response, on 28 May, 2004, petitioners filed a three
(3) month time extension, a reissue declaration naming Stephen A.
Morse, Peter L. Callas, Geoffrey A. Orth, Andrew G.C. Frazier,
and Albert K. Chin as joint inventors and signed by all inventors
except Orth on behalf of themselves and joint inventor Orth.

Petitioners state that a copy of the application papers were sent to joint inventor Orth, but were returned as undeliverable.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks items (1), (2), and (5).

In regards to item (1), petitioners have not shown that diligent efforts were made to locate the non-signing inventor.¹ While petitioners have shown that a copy of the application papers was sent to Orth's last known address, and that the application papers were returned as undeliverable, petitioners have not shown that any efforts were made to determine a new address for Orth. A brief Internet search reveals that Orth may now be living in Sebastopol, CA.

Petitioners should show that diligent efforts were made to determine Orth's current residence and/or mailing address. Petitioners should give or send a copy of the application papers (specification, claims, drawings, if any, and the declaration) at the inventor's last known address. Petitioners should submit a copy of the cover letter transmitting the application papers to the nonsigning inventor at the last known address or, if presented in hand affidavits or declarations of facts by a person having first-hand knowledge of the details thereof.

If the envelope sent to the non-signing inventor at the last known address is returned as undeliverable by the post office, petitioners should provide a copy of the envelope showing that the application was returned as undeliverable with any renewed petition. If the inventor refuses in writing to sign, a copy of that written refusal should be provided with any renewed

¹MPEP 409.03(d).

petition. If the inventor refuses orally, petitioners should submit details of the refusal in an affidavit or declaration of facts by a person having first-hand knowledge of the refusal.

If repeated attempts to contact the non-signing inventor are unsuccessful, petitioners will have shown that despite diligent efforts, the inventor could not be reached.

In regards to item (2), the declaration contains is defective in that it contains non initialed and/or non-dated alterations.² Specifically, there is an uninitialed and/or undated alteration in the signature block for joint inventor Frazier. A new oath or declaration in compliance with 37 CFR 1.63 and 1.67, signed by the inventor to whom the error or deficiency relates is required.³

In regards to item (5), if a more recent last known address is discovered for the last known address, that address must be provided with any renewed petition.

It is noted that petitioners have not been charged the surcharge for late filing of an oath or declaration. The \$130.00 late filing fee or oath or declaration will be charged to counsel's deposit account, No. 19-2555, as authorized in the fee transmittal sheet filed with the present petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 220 20th Street S.
 Customer Window, Mail Stop Petition
 Crystal Plaza 2, Lobby, Room 1B03
 Arlington, VA 22202

²See 37 CFR 1.52(c).

³37 CFR 1.67(a)(2).

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.

A handwritten signature in black ink, appearing to read "D. Wood". The signature is stylized with a large, looped initial "D" and a cursive "Wood".

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions